



8/8/02  
Amend  
J. Willam  
PATENT  
Attorney Docket No. 040894-5643  
8/9/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Satoshi NAKAMURA et al.

Application No.: 09/805,934

Filed: March 15, 2001

For: NOISE PROTECTION SHEET

) Group Art Unit: 2827

) Examiner: T. Dinh

Commissioner of Patents  
Washington, D.C. 20231

Sir:

**AMENDMENT**

In response to the Office Action dated May 8, 2002 (Paper No. 5), the period for response to which extends through August 8, 2002, please amend the above identified application as follows:

**IN THE DRAWINGS:**

In a Request for Approval of Drawing Changes filed concurrently herewith, Applicants respectfully request to amend Fig. 12 to include a legend "Related Art".

**IN THE CLAIMS:**

Please amend claims 1, 2 and 5 to read as follows:

1. (Amended) A noise protection sheet stuck on electronic components loaded on a circuit board to suppress noise generated from the electronic components, comprising:

a metallic sheet, and

insulating films which sandwich the metallic sheet in-between thereof,

wherein

said metallic sheet has, at its one end, an extending portion being externally exposed and being connected to a grounding terminal on the circuit board.

A 1  
2. (Amended) A noise protection sheet according to claim 1, wherein said metallic sheet has a first area covered with said insulating films and a second area forming the extending portion.

5. (Amended) An apparatus for mounting a noise protection sheet on electronic components loaded on a circuit board, the noise protection sheet comprising a metallic sheet and insulating films sandwiching said metallic sheet in-between, further comprising:

A 2  
carrying means for carrying said noise protection sheet held on a carrier tape;

moving means for chucking said noise protection sheet and moving it from the carrier tape onto the electronic components on said circuit board; and

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*cont'd*  
soldering means for soldering an extending portion externally exposed and formed at the

*p2* one end of said metallic sheet to a grounding terminal of said circuit board.

**REMARKS**

**Summary of the Office Action**

The drawings stand objected to because of informalities.

Claim 1 stands objected to because of informalities.

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Prior Art submitted by Applicants in view of *Goenka et al.* (U.S. Patent No. 5,968,386).

**Summary of the Response to the Office Action**

Applicants have amended claims 1, 2 and 5 to more clearly define the invention.

Accordingly, claims 1-6 are presently pending. Claim 6 is withdrawn from consideration.

In addition, Applicants submit concurrently herewith a Request for Approval of Drawing Change. Attached hereto is a marked-up version of the changes made by the current amendment. The attached page is captioned, "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

**Objection to the Drawings**

Figs. 11 and 12 stand objected to because they are not labeled as "Related Art."

Applicants respectfully submit that Fig. 11 shows an embodiment of the present application and should not be labeled as "Related Art." In a Request for Drawing Changes filed concurrently herewith, Applicants propose to amend the drawings by labeling Fig. 12 as "Related Art."

Accordingly, Applicants respectfully request that the objection to Figs. 11 and 12 be withdrawn.

**The Objection to Claim(s)**

Claim 1 is objected to because of informalities. Applicants have amended claim 1 to address the Examiner's concerns. Accordingly, Applicants respectfully request the objection to claim 1 be withdrawn.

**The Rejections under 35 U.S.C. §103(a)**

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Prior Art submitted by Applicants in view of *Goenka et al.* Applicants respectfully traverse the rejections as explained below.

With respect to independent claim 1, as newly-amended, Applicants respectfully submit that Prior Art submitted by Applicants and *Goenka et al.*, whether taken singly or combined, do not teach or suggest the claimed combination including at least "said metallic sheet has, at its one end, an extending portion being externally exposed and being connected to a grounding terminal on the circuit board."

The Office Action appears to suggest that a metal foil layer 16m of *Goenka et al.* meets the "metallic sheet" limitations of the claimed invention. However, as shown in Figs. 1-7 of *Goenka et al.*, Applicants respectfully submit that the metal foil layer 16m is entirely covered by a plastic layer 16p and does not have, "at its one end, an extending portion being externally exposed," as recited by newly-amended independent claim 1. Thus, Applicants respectfully submit that *Goenka et al.* fails to teach or suggest the claimed combination of independent claim

1, as newly-amended. Because Prior Art submitted by Applicants does not cure the deficiencies of *Goenka et al.* as discussed above with regard to newly-amended independent claim 1, Applicants respectfully submit that Prior Art submitted by Applicants and *Goenka et al.*, whether taken alone or in combination, do not teach or suggest each feature of independent claim 1, as newly-amended.

For similar reasons set forth above, Applicants respectfully submit that Prior Art submitted by Applicants and *Goenka et al.*, whether taken alone or in combination, do not teach or suggest the claimed combination including at least "soldering means for soldering an extending portion externally exposed and formed at the one end of said metallic sheet to a grounding terminal of said circuit board," as recited by newly-amended independent claim 5.

Therefore, Applicants respectfully request that the rejections of claims 1 and 5 under 35 U.S.C. §103(a) based on Prior Art and *Goenka et al.* be withdrawn at least because neither Prior Art nor *Goenka et al.* teaches nor suggests each feature of newly-amended independent claims 1 and 5. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Further, Applicants respectfully assert that rejections of dependent claim 2, as newly-amended, and dependent claims 3 and 4 under 103(a) should also be withdrawn at least because of the dependence from the newly-amended independent claims 1 and 5 and for the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 1-5 are allowable.

**Conclusion**

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

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